

10



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/493,854 | 01/28/2000 | Charles Eric Hunter | WT_6 | 2737 |

7590 01/15/2002
Finnegan, Henderson, Farabow
Garrett & Dunner L.L.P
1300 I Street NW
Washington, DC 20005-3315

RECEIVED

JAN 23 2002

FINNEGAN, HENDERSON,
FARABOW, GARRETT & DUNNER, LLP.

| | |
|--------------------|--------------|
| 8159-0008 | |
| EXAMINER | |
| O CONNOR, GERALD J | |
| ART UNIT | PAPER NUMBER |
| 2167 | |

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Docketed 01/23/02 Attorney REC
Case 08159-0008
Due Date 02/15/02 W/EXT
Action 1 mon ELECTION DIVE
By AS

1-23-02

AW

Office Action Summary

Application No.

09/493,854

Applicant(s)

Hunter et al.

Examiner

O'Connor

Art Unit

2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 18, 2001 (Preliminary Amendment "A").
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 2167

DETAILED ACTION

Preliminary Remarks

1. Applicant may disregard the first Office action (Paper N^o 4) prepared in this application, the Office action having crossed in the mail with the preliminary amendment submitted by applicant on October 18, 2001 (Paper N^o 5).
2. This second Office Action has been prepared in response to the preliminary amendment filed by applicant on October 18, 2001 (Paper N^o 5).
3. The addition of claims 3-51 by applicant in Paper N^o 5 is hereby acknowledged.

Election/Restriction

4. Restriction to one of the following two inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to an automated electrical financial or business practice or management system for bill preparation, classified in class 705, subclass 34.
 - II. Claim 2, drawn to a method of satellite transmission for direct broadcast to homes using digital transmissions having copy prevention means embedded therein comprising an origin or program ID, classified in class 705, subclass 58.

Art Unit: 2167

- III. Claims 3-27, drawn to an automated electrical financial or business practice or management system for accounting, classified in class 705, subclass 30.
- IV. Claims 28-41, drawn to a method of transmission of signals for recording, combined with diverse art device (e.g. computer, telephone, etc.), classified in class 348, subclass 552.
- V. Claims 42-51, drawn to a electronic broadcast information distribution system including reverse (upstream) communication, combined with diverse device (e.g. computer, VCR, etc.), classified in class 725, subclass 133.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions II and IV are each related to each of Inventions I, III, and V, as process and apparatus for its practice. The inventions are distinct if it can be shown that *either*: (1) the process as claimed can be practiced by another, materially different apparatus, or by hand, *or* (2) the apparatus as claimed can be used to practice another, materially different process. (MPEP § 806.05(e)).

In this case, the apparatus as claimed can be used to practice another, materially different process, such as either the process of Invention II or the process of Invention IV, which two processes are mutually separate and distinct, as explained hereinbelow.

Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

Art Unit: 2167

separately usable. In this case: Invention II has separate utility from Invention IV, such as for use in pre-selecting music to later record while the system is unattended; and, Invention IV has separate utility from Invention II, such as for use in selecting music to record in real-time, as it is broadcast to a live person listening to the broadcast and making selections "on-the-fly." See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. A telephone call was placed to Mr. Robert E. Converse, Jr. (Reg. N^o 27,432), attorney of record for applicant, on January 9, 2002, to discuss an oral election to the above restriction requirement, but the call did not result in an election being made.

8. Applicant is advised that a reply to this requirement, to be complete, *must* include an election of the invention to be examined, even if the requirement be traversed (37 CFR 1.143).

Serial Number: 09/493,854

Page 5

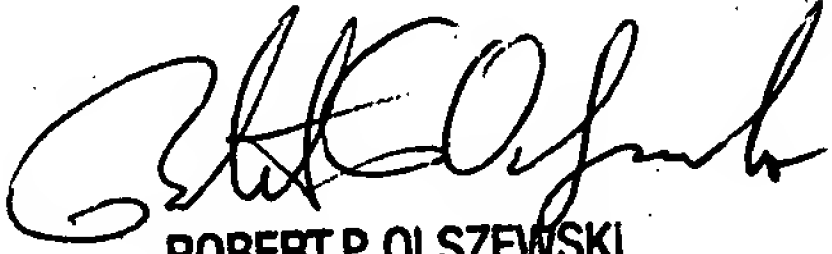
Art Unit: 2167

Conclusion

9. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525.

GJOC

January 9, 2002

 1/14/02
ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600 2 100